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09/941,274	08/28/2001	William Michael Bondy	29250/CE08591R	7243
29978	7590	12/15/2004	EXAMINER	
MARSHALL, GERSTEIN & BORUN (MOTOROLA)			HASHEM, LISA	
233 SOUTH WACKER DRIVE			ART UNIT	
SUITE 6300			PAPER NUMBER	
CHICAGO, IL 60606-6402			2645	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/941,274

Applicant(s)

BONDY ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S.

Patent No. 6,633,636 by McConnell et al, hereinafter McConnell.

Regarding claim 1, McConnell discloses a method for providing mobile feature information (Figure 2, 36) to enable a mobile feature, e.g. call forwarding (see Figure 4; column 7, lines 9-41), on a land line element (Figure 2, 22) within a communication network (see Figure 1; column 3, lines 58-67), the communication network providing communication services for a subscriber (see Abstract), wherein the communication network includes a services client element or FEP (Figure 3) being operable to retrieve mobile feature information based on a registration associated with the subscriber (column 4, line 65 – column 5, line 8; column 5, lines 36-48; column 6, lines 49-62), and wherein the subscriber accesses the communication network via an access network (Figure 2, 14), the method comprising: receiving mobile feature information from the services client element (column 6, lines 49-58), translating the mobile feature information (Figure 3, column 6, line 49 – column 7, line 6); and transmitting the mobile feature information to the land line element via a second interface, wherein the mobile feature

information is associated with the mobile feature (Figure 3; column 6, lines 31-48; column 7, lines 9-41).

Regarding claim 2, the method of claim 1, wherein McConnell further discloses the step of receiving mobile feature information from the services client element comprises receiving mobile feature information from the services client element based on information associated with location of a mobile station the subscriber (column 4, line 65 – column 5, line 8; column 5, lines 35-48; column 6, line 63 – column 7, line 6).

Regarding claim 3, the method of claim 1, wherein McConnell further discloses the step of receiving mobile feature information from the services client element comprises receiving mobile feature information from the services client element via a first interface (column 6, lines 49-62), and wherein the first interface comprises one of a session initiation protocol (SIP) interface and an application program interface (API) (Figure 3; column 6, lines 31-62).

Regarding claim 4, the method of claim 1, wherein McConnell further discloses the step of receiving mobile feature information from the services client element comprises receiving one of a phone number, an electronic mail address, an Internet Protocol (IP) address, a billing rate, and a status message from the services client element (column 5, lines 36-48; column 6, lines 49-62).

Regarding claim 5, the method of claim 1, wherein McConnell further discloses the step of transmitting the mobile feature information to the land line element comprises transmitting the mobile feature information to one of a provisioning database and a call agent (Figure 3; column 6, line 31 - column 7, line 6).

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Regarding claim 6, the method of claim 1, wherein McConnell further discloses the step of transmitting the mobile feature information to the land line element comprises transmitting the mobile feature information to the land line element via a second interface, and wherein the second interface comprises one of a provisioning interface, a session initiation protocol (SIP) interface, and an H.323 interface (Figure 3; column 6, lines 31-48).

Regarding claim 7, the method of claim 1, wherein McConnell further discloses the access network comprises a radio access network (column 4, lines 10-44).

Regarding claim 8, McConnell discloses a method for enabling a mobile feature, e.g. call forwarding (see Figure 4; column 7, lines 9-41), on a land line element (Figure 2, 22) within a communication network (see Figure 1; column 3, lines 58-67), the communication network providing communication services for a subscriber (see Abstract), wherein the subscriber accesses the communication network via an access network (Figure 2, 14), the method comprising: receiving a registration associated with the subscriber; retrieving mobile feature information based on the registration (column 4, line 65 – column 5, line 8; column 5, lines 36-48; column 6, lines 49-62); translating the mobile feature information (Figure 4; Figure 3, column 6, line 49 – column 7, line 6); and transmitting the mobile feature information to the land line element (Figure 3; column 6, lines 31-48; column 7, lines 9-41).

Regarding claims 9-13, the method of claim 8, wherein please see the rejections of claims 2, 4, and 5-7, respectively, to reject claims 9-13.

Regarding claim 14, McConnell discloses a communication network (see Figure 1; column 3, lines 58-67) for providing communication services for a subscriber (see Abstract), the communication network being operable to enable a mobile feature, e.g. call forwarding (see

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Figure 4; column 7, lines 9-41), on a land line element (Figure 2, 22), wherein the subscriber accesses the communication network via an access network (Figure 2, 14), the communication network comprising: a home subscriber server or HLR (column 5, lines 26-48); a services client element or FEP coupled for communication with the home subscriber server (column 5, lines 26-35; column 6, lines 49-58), the services client element being operable to retrieve mobile feature information based on a registration associated with the subscriber (column 4, line 65 – column 5, line 8; column 5, lines 36-48; column 6, lines 49-62); and a database translation feature server (Figure 3, 62) coupled for communication with the services client element (see Figure 3), the database translation feature server being operable to translate the mobile feature information from the services client element, wherein the database translation feature server inherently transmits the mobile feature information to a land line element (column 6, line 31 – column 7, line 6).

Regarding claim 15, the communication network of claim 14, wherein McConnell further discloses the registration comprises information associated with location of a mobile station the subscriber (column 5, lines 36-48).

Regarding claim 16, the communication network of claim 14, wherein McConnell further discloses the land line element comprises one of a provisioning database and a call agent (column 6, line 63 – column 7, line 6).

Regarding claim 17, the communication network of claim 14, wherein McConnell further discloses the database translation feature server is coupled for communication with the services client element via a first interface (see Figure 3; column 6, lines 49-66), and wherein the first

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interface comprises one of a session initiation protocol (SIP) interface and an application program interface (API) (column 6, lines 31-66).

Regarding claim 18, the communication network of claim 14, wherein McConnell further discloses the database translation feature server is coupled for communication with the land line element via a second interface (see Figure 3; column 6, lines 31-48), and wherein the second interface comprises one of a provisioning interface, a session initiation protocol (SIP) interface, and an H.323 interface (column 6, lines 31-66).

Regarding claims 19 and 21, the method of claim 14, wherein please see the rejections of claims 4 and 7, respectively, to reject claims 19 and 21.

Regarding claim 20 the communication network of claim 14, wherein McConnell further discloses the database translation feature server is integrated into the services client element (see Figure 3; column 6, lines 59-66).

Regarding claims 22-30, please see the rejections of claims 1, 2, 4, 3, 8, 6, 5, and 7, respectively, to reject claims 22-30, wherein a server operates in accordance to a computer program embodied on a computer-readable medium for enabling a mobile feature on a land line element (column 4, line 55 – column 6, line 62; column 7, lines 9-41). Wherein, the wireless/PBX interface comprises the FEP (Figure 3; column 6, line 4 – column 7, line 6).

Regarding claim 30, the computer program of claim 22, wherein McConnell further discloses the medium comprises one of paper, a programmable gate array, application specific integrated circuit, erasable programmable read only memory, read only memory, random access memory, magnetic media, and optical media (column 6, line 4 – column 7, line 6).

***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,134,333 by Joong et al disclose in a radio telecommunications network, a system for providing call forwarding based upon the type of call, wherein mobile feature information, e.g. forwarding a data call, is enabled on a land line element, e.g. a fax
- U.S. Patent Application No. US 2002/0137498 by Goss et al disclose a method for providing automatic call-forwarding service for a mobile unit to another wireline phone

4. Any response to this action should be mailed to:

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**Or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

**Or call:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

December 2, 2004

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
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